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SECOND PRE-APPEAL BRIEF REQUEST FOR REVIEW	Docket Number (Optional) JRL-3995-50 Confirmation No. 7820

	Application Number 10/584,861	Filed June 28, 2006

(OPAP stamp: MAR 31 2011 PATENT & TRADEMARK OFFICE, IAP13)

First Named Inventor SKOG	
Art Unit 2467	Examiner Cattungal, Ajay P.

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).
   Note: No more than five (5) pages may be provided.

I am the
☐ Applicant/Inventor

☐ Assignee of record of the entire interest. See 37 C.F.R. § 3.71. Statement under 37 C.F.R. § 3.73(b) is enclosed. (Form PTO/SB/96)

☒ Attorney or agent of record   33,149
                                    (Reg. No.)

☐ Attorney or agent acting under 37CFR 1.34.
   Registration number if acting under 37 C.F.R. § 1,34 _____

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March 31, 2011
_____
Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below.*

☒ *Total of 1 form/s are submitted.

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of

SKOG et al

Appl. No. 10/584,861

Filed: June 28, 2006

Atty. Ref.: 3995-50; Confirmation No. 7820

TC/A.U. 2467

Examiner: Cattungal, Ajay P.

For: METHOD AND COMMUNICATION SYSTEM FOR AUTOMATICALLY DISCOVERING THE COMMON MULTIMEDIA SERVICE CAPABILITY

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March 31, 2011

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SECOND PRE-APPEAL BRIEF REQUEST FOR REVIEW

After the first pre-appeal, the main rejection based on Ahuja and Roy was withdrawn. Now, the main rejection is based on Ahuja in view of newly-applied Sylvain. There are also clear errors with this new set of rejections.

Claim 1 recites in part: "responding to said user terminals with information regarding matching multimedia capabilities and alerting users of the user terminals of a possibility to start a packet-switched shared multimedia service session only if at least one common multimedia service capability is found for the user terminals; wherein said notifying, analyzing, and responding steps are performed prior to the packet-switched shared multimedia service session being initiated, and initiating the shared multimedia service session only if at least one common multimedia service capability is found for the user terminals."

Ahuja teaches a multimedia telecommunication system that supports simultaneous voice and multimedia communication using virtual meeting services (VMS). Although Ahuja describes the network automatically identifying the multimedia capabilities of the calling party and the called party in response to a call initiated by the calling party, (col. 13, lines 62-65), Ahuja moves the multimedia call forward even if there is a mismatch in the media communications capabilities of those parties or incompatibility between the communications

equipment of the calling party and the called party. Col. 14, lines 11-25. "The network will appropriately configure interface equipment to permit parties having these incompatibilities to communicate with one another in selected media," col. 14, lines 25-28.

Sylvain describes a terminating telephony switch monitoring a call setup message to detect whether a calling party and/or a called party associated with an incoming call is/are associated with multimedia capability as indicated by a flag or based on a multimedia address associated with the media device of the caller included in the call setup message. An originating telephony switch "creates call setup messages to provide multimedia capability information to enable the multimedia detection functionality of the terminating telephony switch." (Abstract.)

Clear Error #1: The Combination of Ahuja and Sylvain Fails to Teach "alerting users of the user terminals of a possibility to start a packet-switched shared multimedia service session only if at least one common multimedia service capability is found for the user terminals" recited in Claim 1

The Examiner admits that Ahuja lacks alerting user of a possibility to start a packet-switched (PS) shared multimedia session, but points to col. 5, lines 5-22 of Sylvain for this feature. This text describes SIP endpoints, each of which "is capable of running an application, typically referred to as a user agent (UA), which is capable of facilitating media sessions using SIP." Col. 4, lines 53-54. Sylvain explains that "SIP is used to establish media sessions between any number of endpoints. Typically, these endpoints may support any number or combination of data, audio, and voice media sessions, depending on the configuration of the device." Col. 4, lines 48-53. So according to Sylvain, SIP endpoints support a multimedia session by definition. The text at col. 5, lines 5-22 is based on this definition and describes a packet-switched SIP session that has already been established between SIP user agents.

In contrast, in claim 1, the users are alerted of the possibility to start a multimedia service session only if it has been established that matching multimedia service capabilities do exist so that it is actually possible to start a multimedia session between the users. Unlike Sylvain, the technology in claim 1 sends user alerts of possible multimedia services before a packet-switched session is established.

The signalling diagram in Figure 2 of Sylvain shows a situation where calling terminal 16A does not have multimedia service capabilities. The receiving telephony switch detects that fact, and ultimately, only a voice call is set up between terminals 16A and 16B. No signal is

shown in Figure 2 going to the calling or called telephony terminals 16A or 16B or the terminal users with any multimedia-related alert.

It is also important to note that a SIP session is established in Sylvain between multimedia client (MMC) 22A and MMC 22B, even though a multimedia session ultimately is not possible between there corresponding terminals 16A and 16B. In fact, Sylvain explains for this Figure 2 situation: "[e]ven though *the incoming call will not be associated with a media session,* telephony switch 14B *initiates multimedia services* by interacting with service node 30B, which will facilitate multimedia services." Col. 6, lines 55-59 (emphasis added). Unlike the claimed technology, Sylvain consumes multimedia services even though one of the terminals does not have the multimedia capabilities needed for the requested multimedia session.

Figure 3 of Sylvain shows signalling when both terminals 16A and 16B have a multimedia client, i.e., MMC 22A and MMC 22B, respectively. The MMC's confirm that a multimedia session is possible and move forward with the session. See, e.g., col. 7, lines 49-56. But there is no signal shown in Figure 3 alerting either terminal 16A and 16B or either terminal user of the possibility to start a multimedia service session, let alone alerting either terminal 16A and 16B or either terminal user of the possibility to start a multimedia service session only if at least one common multimedia service capability is found for the user terminals.

Thus, even if Ahuja and Sylvain could be combined as the Examiner proposes, their combined teachings still fail to disclose or suggest: "alerting users of the user terminals of a possibility to start a packet-switched shared multimedia service session only if at least one common multimedia service capability is found for the user terminals," as recited in claim 1.

Clear Error #2: The Combination of Ahuja and Sylvain Fails to Teach the "Wherein Clause" and Initiating Step recited in Claim 1

Claim 1 further recites "wherein said notifying, analyzing, and responding steps are performed prior to the packet-switched shared multimedia service session being initiated" (the "wherein clause") and "initiating the shared multimedia service session only if at least one common multimedia service capability is found for the user terminals." Because the responding step referred to in the claimed wherein clause includes the user alert feature missing from both Ahuja and Sylvain as just explained, Ahuja and Sylvain thus also fail to teach the claimed wherein clause.

As a further point of distinction, the Examiner now agrees that the initiating step is missing from Ahuja but contends that it is disclosed at col. 3, lines 1-20 of Sylvain. Yet, as pointed out above, Sylvain explicitly uses multimedia services even though one of the terminals does not have the multimedia capabilities needed for the requested multimedia session. See again col. 6, lines 55-59. Because a packet-switched multimedia service session is not initiated in claim 1 unless it is determined that it is possible to establish such a multimedia service session, the method of claim 1 conserves multimedia service resources in contrast to the proposed combination of Ahuja and Sylvain.

Clear Error #3: The Combination of Ahuja and Sylvain Is Improper

In combining Ahuja and Sylvain, the Examiner overlooks a fundamental difference between Ahuja and Sylvain because in Ahuja: "[m]ultimedia connections between those workstations 156 and 158 are **automatically set up** in response to simply dialing the regular directory number of the workstation 158 by the user of workstation 156 on the telephone 166." Col. 14, lines 51-54. Even if only one party is a VMS subscriber, Ahuja describes: "If it is determined, in block 298, that only the calling party is a VMS subscriber, then multiple media connections are set up only for the calling party in block 302. These multiple media connections are set up in case a VMS subscriber is added to the conference between the VMS subscriber using workstation 156 and the nonVMS subscriber using workstation 158." Col. 15, lines 28-34. Thus, contrary to what is claimed, Ahuja sets up multimedia connections even though only the calling party is a multimedia-capable device. But this setting up of multiple media connections "just-in-case" *teaches away* from what is claimed where the shared multimedia service session is only initiated if at least one common multimedia service capability is found for the user terminals. "A reference may be said to teach away when a person of ordinary skill, upon reading the reference, would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path that was taken by the applicant." *In re Gurley*, 27 F.3d 551, 553 (Fed. Cir. 1994).

Moreover, if one modified Ahuja as the Examiner suggests with Sylvain, then Ahuja would not longer be able to provide the "just-in-case" feature intended by Ahuja. A proposed modification that renders a prior art reference inoperable for its intended purpose is inappropriate for an obviousness inquiry. *In re Fritch*, 972 F.2d 1260, 1265-66 (Fed. Cir. 1992).
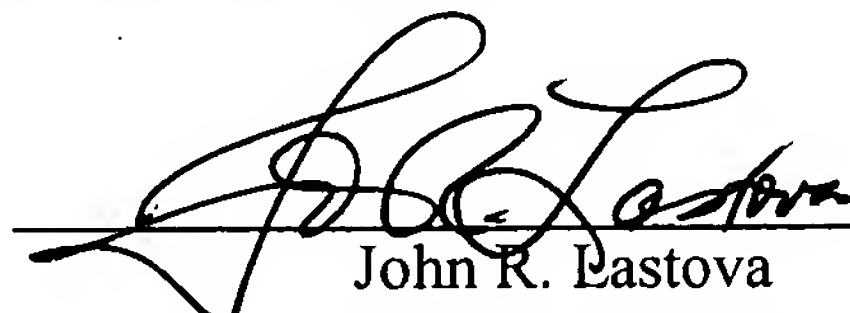
Thus, there are multiple clear errors in the rejection of claim 1. Although claims 9 and 18 are of differing scope from claim 1, the rejection of claims 9 and 18 also contains legal and factual errors for at least analogous reasons. Withdrawal of the primary rejection is requested.

Clear Error #4: The Rejection of Dependent Claims Is Improper

Various dependent claims stand rejected as being unpatentable over Ahuja and Sylvain in view of Aholainen or Vaananan. These rejections are traversed because neither Aholainen nor Vaananan overcome the deficiencies noted above for Ahuja combined with Sylvain. Moreover, the addition of a third reference is further evidence of nonobviousness. The rejection based on Vaananan is particularly unfounded since the text in col. 5 referred to by the Examiner relates to forwarding an advertising message to a GSM terminal and has nothing to do with "alerting the user of the possibility to start a multimedia service session," as recited in claims 6, 14, and 22. As for claims 7, 15, and 23, Vaananan does not teach at col. 5, lines 19-24 that "the user terminals will not start a packet switched session until said message [for alerting the user of the possibility to start a multimedia service session] has been received by the two user terminals."

Respectfully submitted,
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